

REMARKS

In the Office Action,¹ the Examiner approved the amendment to the specification and the new title, thus withdrawing the objections to the title and the specification for informalities. The Examiner also raised the possibility of a rejection of claim 16 under 35 U.S.C. § 112, first paragraph, and encouraged Applicant to contact the Examiner to discuss possible claim amendments.

I. Summary of Interview

In accordance with the Examiner's request, Applicant's representative discussed possible claim amendments with the Examiner during a telephone interview on May 19, 2006. During the interview, the Examiner proposed amendments to claim 16, including the possibility of canceling claims 19 and 21 and incorporating their subject matter into claim 16. Specific prior art references were not discussed, nor was any agreement on an amendment reached.

In addition, the Examiner discussed the possibility of rejecting claim 16 under 35 U.S.C. § 112, first paragraph, but ultimately concluded that the possibility of such a rejection was remote.

II. Procedural Issues Regarding the Rejection

As clarified during the telephone interview, the Examiner maintained all claim rejections set forth in the Office Action dated September 23, 2005. Specifically, claim 16 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

with the written description requirement; claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as being ambiguous or confusing; and claims 16-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,669,730 to Small ("Small").

However, the Examiner did not address the substance of Applicant's rebuttal remarks made in the Reply to Office Action dated December 21, 2005 ("the Previous Reply"). According to M.P.E.P. § 707.07(f), "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant's argument and answer the substance of it.*" (Emphasis added.) Because the Examiner failed to take note of and answer the substance of Applicant's previously filed remarks made to rebut the claim rejections, Applicant respectfully renews the previously filed remarks. In particular, Applicant renews Sections B and C of the Previous Reply, which are repeated under Section III below for the Examiner's convenience. Should the Examiner continue to maintain the claim rejections, Applicant respectfully requests that the Examiner address the substance of Applicant's previously filed remarks, as required by the M.P.E.P.

III. Claim Rejections

A. Claim Rejections Under 35 U.S.C. § 112

In the Previous Reply, Applicant canceled the elements of claim 16 that the Examiner could not find support for in Applicant's original disclosure and that were allegedly ambiguous or confusing. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of claim 16 under 35 U.S.C. § 112, first and second paragraphs.

B. Claim Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 16-21 under 35 U.S.C. § 103(a) as being unpatentable over Small. No *prima facie* case of obviousness exists with respect to claims 16-21 for at least the reason that Small, taken alone or in combination with the Examiner's Official Notice, does not teach or suggest each and every element recited in the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th Ed., Rev. 2, May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in applicant's disclosure." M.P.E.P. § 2143 (8th Ed., Rev. 2, May 2004).

For example, claim 16 recites, among other things, "operating a random number generator to set a jackpot threshold, and . . . determining a win or no win condition, where a win condition indicates that [a] jackpot total equals or exceeds the set jackpot threshold."

Small discloses a system for promoting or encouraging the use of financial institution transacting devices, such as ATMs and Point of Sale terminals. See Small, col. 2, lines 40-51. Small further discloses generating a random number to compare it with an "account number or other selected user indicia" to determine "whether a winning

correlation exists between the two numbers.” See col. 2, lines 52-58, and col. 3, lines 30-54. In contrast, claim 16 requires “operating a random number generator to set a jackpot threshold, and . . . determining a win or no win condition, where a win condition indicates that [a] jackpot total equals or exceeds the set jackpot threshold.” Thus, the random number in Small is generated for a different purpose and Small determines a win or no win condition in a different manner.

The Examiner’s Official Notice, alleging that “it is well taught in the art that a manufacturer or retailer may provide an incentive (dollar amount) to a customer for performing a particular task,” fails to cure the deficiency of Small noted above.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 16 under 35 U.S.C. § 103(a). Claims 17-21 depend from and add additional features to independent claim 16. Accordingly, these claims are allowable for at least the reasons set forth above.

Conclusion

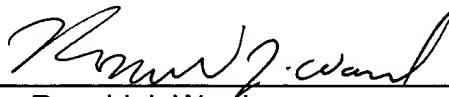
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this reply and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 9, 2006

By: 

Ronald J. Ward
Reg. No. 54,870